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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,964	10/04/2004	Shoichi Ishikawa	1391.1061	1007
21171 7590 03/05/2008 STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER ADAMS, CHARLES D	
			ART UNIT 2164	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/509,964	ISHIKAWA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	CHARLES D. ADAMS	2164	

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 December 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Remarks*

1. In response to communications filed on 27 December 2007, claims 1 and 7-9 are amended. Claims 1 and 3-9 are pending in the application.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 7 rejected under 35 U.S.C. 101 because though the claims are directed towards a system, the claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Both types of "descriptive material" are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lawry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994).

Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make is statutory. See *Diehr*, 450 U.S. at 185-186, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because “[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.”).

### ***Specification***

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

Claim 8 is directed towards a computer-readable storage medium. However, no recitation of storage medium appears in the specification.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 3, and 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Milovanovic (US Pre-Grant Publication 2003/0065728) in view of Horn (US Pre-Grant Publication 2004/0177319).

As to claim 1, Milovanovic teaches:

analyzing a folder configuration created on mail software in order to obtain information regarding the folder configuration and creating a scanned data folder accessible by the mail software, if necessary (see paragraph [0024] and Figure 2, element 101);

Milovanovic does not teach:

creating the same folder configuration in a file system that is shared by the mail software

Horn teaches creating the same folder configuration in a file system that is shared by the mail software (see Horn paragraphs [0104], [0133], and [0135]),

Milovanovic as modified teaches and reads documents by use of a scanner (see Horn paragraphs [0041] and [0043] and Milovanovic paragraph [0024]), copies those documents into the scanned data folder and files the documents on the basis of the obtained information (see Milovanovic paragraph [0024] and Horn paragraphs [0133] and [0135]); and

performing file management by executing filing processing for the created folder configuration (see paragraphs [0104], [0133], and [0135]), wherein

the analysis of the folder configuration is performed at the time of startup of the file management software, regularly, or upon user's requests (see Horn paragraph [0179]), and

when the folder configuration of the mail software differs from that of the file system, the folder configuration of the file system is updated to match that of the mail software (see Horn paragraph [0179]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Milovanovic by the teachings of Horn, because Horn teaches that “the inventive MFS-enabled computer system’s catalog mechanism provides unlimited support for new types of objects and new metadata, regardless of the underlying file system of operating system’s features or lack thereof” (see paragraph [0139]).

As to claim 3, Milovanovic as modified teaches wherein mail data items are obtained from the mail software and are stored in corresponding folders created in the file system and mail data and other files are managed in the file system under a same environment (see Horn paragraphs [0139] and [0179]).

As to claim 5, Milovanovic as modified teaches wherein the folder configuration of the mail software is created on two or more storage units (see Horn paragraph [0179]).

As to claim 6, Milovanovic as modified teaches wherein image data read by use of a scanner are simultaneously stored in the two or more storage units (see Horn paragraph [0179]).

As to claim 7, Milovanovic teaches:

a folder configuration analysis section analyzing a folder configuration created on mail software in order to obtain information regarding the folder configuration and creating a scanned data folder accessible by the mail software, if necessary (see paragraph [0024] and Figure 2, element 1);

Milovanovic does not teach:

a folder configuration creation section creating the same folder configuration in a file system that is shared by the mail software

Horn teaches:

a folder configuration creation section creating the same folder configuration in a file system that is shared by the mail software (see Horn paragraphs [0104], [0133], and [0135]),

Milovanovic as modified teaches:

and that reads documents by use of a scanner (see Horn paragraphs [0041] and [0043] and Milovanovic paragraph [0024]), copies those documents into the scanned data folder and files the documents on the basis of the obtained information (see Milovanovic paragraph [0024] and Horn paragraphs [0133] and [0135]), wherein file management is performed by executing filing processing for the file folder configuration created by the folder configuration creation section (see paragraphs [0104], [0133], and [0135]),

the analysis of the folder configuration is performed at the time of startup of the file management software, regularly, or upon user's requests (see Horn paragraph [0179]), and

when the folder configuration of the mail software differs from that of the file system, the folder configuration of the file system is updated to match that of the mail software (see Horn paragraph [0179]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Milovanovic by the teachings of Horn, because Horn teaches that "the inventive MFS-enabled computer system's catalog mechanism provides unlimited support for new types of objects and new metadata, regardless of the underlying file system of operating system's features or lack thereof" (see paragraph [0139]).

As to claim 8, Milovanovic teaches:

analyzing a folder configuration created on mail software in order to obtain information regarding the folder configuration and creating a scanned data folder accessible by the mail software, if necessary (see paragraph [0024] and Figure 2, element 1);

Milovanovic does not teach:

creating the same folder configuration in a file system that is shared by the mail software

Horn teaches:



creating the same folder configuration in a file system that is shared by the mail software (see paragraphs [0104], [0133], and [0135]);

Milovanovic as modified teaches and that reads documents by use of a scanner (see Horn paragraphs [0041] and [0043] and Milovanovic paragraph [0024]), copies those documents into the scanned data folder, and files the documents on the basis of the obtained information (see Milovanovic paragraph [0024] and Horn paragraphs [0133] and [0135]); and

performing file management by executing filing processing for the created folder configuration (see Horn paragraphs [0104], [0133], and [0135]), wherein

the analysis of the folder configuration is performed at the time of startup of the file management software, regularly, or upon user's requests (see Horn paragraph [0179]), and

when the folder configuration of the mail software differs from that of the file system, the folder configuration of the file system is updated to match that of the mail software (see Horn paragraph [0179]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Milovanovic by the teachings of Horn, because Horn teaches that "the inventive MFS-enabled computer system's catalog mechanism provides unlimited support for new types of objects and new metadata, regardless of the underlying file system of operating system's features or lack thereof" (see paragraph [0139]).

As to claim 9, Milovanovic teaches:

analyzing, at the time of startup of the file management software, a folder configuration created on mail software in order to obtain information regarding the folder configuration, and creating a scanned data folder accessible by the mail software, if necessary (see paragraph [0024] and Figure 2, element 1); and

Milovanovic does not teach creating the same folder configuration in a file system that is shared by the mail software

Horn teaches creating the same folder configuration in a file system that is shared by the mail software (see paragraphs [0104], [0133], and [0135])

Milovanovic as modified teaches and that reads documents by use of a scanner (see Horn paragraphs [0041] and [0043] and Milovanovic paragraph [0024]), copies those documents into the scanned data folder and files the documents on the basis of the obtained information (see Milovanovic paragraph [0024] and Horn paragraphs [0133] and [0135]), wherein

when the folder configuration of the mail software differs from that of the file system, the folder configuration of the file system is updated to match that of the mail software (see Horn paragraph [0179]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Milovanovic by the teachings of Horn, because Horn teaches that "the inventive MFS-enabled computer system's catalog mechanism provides unlimited support for new types of objects and new metadata,

regardless of the underlying file system of operating system's features or lack thereof" (see paragraph [0139]).

7. Claims 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Milovanovic (US Pre-Grant Publication 2003/0065728) in view of Horn (US Pre-Grant Publication 2004/0177319) and further in view of Sykes, JR. (US Pre-Grant Publication 2002/0129108).

Milovanovic teaches the method of claim 1.

Milovanovic does not teach wherein when a file is stored in a folder in the file system, a mail including information regarding a link to the file, detailed information of the file, and the file itself is transmitted to a mail address of a user, whereby the file is managed on the mail software

Sykes, JR teaches wherein when a file is stored in a folder in the file system, a mail including information regarding a link to the file, detailed information of the file; and the file itself is transmitted to a mail address of a user, whereby the file is managed on the mail software (see Figures 2a and 2b, paragraphs [0010] and [0011]. When a message from the mail software is stored in the alternate file system, the system transmits a receipt to the sender that includes the original message (file). The receipt includes information regarding a link (a sender is told that it exists and is archived), detailed information of the file (the original message), and, as stated, the original message itself. As the receipt is transmitted to the user via email, the user may then manage the file on his or her email software).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Brown et al. by the teaching of Sykes, JR since Sykes, JR teaches that "a problem with electronic communications versus their paper-based counterparts is that some electronic communications can be altered, sometimes without detection, and thus it is difficult to verify what was sent, when it was sent, or when it was received" (see paragraph [0003]).

### ***Response to Arguments***

8. Applicant's arguments with respect to claims 1 and 3-9 have been considered but are moot in view of the new ground(s) of rejection.

**Conclusion**


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHARLES D. ADAMS whose telephone number is (571)272-3938. The examiner can normally be reached on 8:30 AM - 5:00 PM, M - F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Rones can be reached on (571) 272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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